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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,880	05/01/2001	Robert Harada	3013/21	5913

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/846,880	Applicant(s) HARADA ET AL.	
	Examiner Harish T. Dass	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-21, 23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-21,23 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/4/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/04/2006 has been entered.

Claims 7, 22, and 24 are canceled.

DETAILED ACTION

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotton et al (hereinafter Cotton - US 6,076,074) in view of Riboud (US 6,269,345), Komem et al (hereinafter Komem – US 6,892,184) and Szoc et al. (hereinafter Szoc – US 2002/0023053 A1).

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Re. Claim 1, Cotton discloses creating a payment instruction to transfer funds from the source account to the local currency account [Abstract; Figures 2-3; col. 1 lines 37-48, lines 55-63; col. 2 lines 4-5; C4 L23 to C5 L67; col. 16 lines 15-23-- since the fund transfer is for foreign exchange, it is obvious that the accounts settlement are done in local currency, therefore the accounts are inherently in local currency unless it is specified the account is not in local currency, also see specification page 1 - background of invention]; communicating the payment request to a funds source associated with the source account; wherein: in accordance with the payment request, funds are transferred from the funds source (source account) to a treasury (FRB2) account if necessary to maintain a balance at the treasury account which is sufficient to cover an amount of the payment request, and funds at the treasury account are used to provide at least one of (a) a payment to and receiving from a user via a network a transaction request to transfer funds from the source account to the local currency [Cotton – C1 L10-L64; C2 L50 to C3 L15; C3 L65-67; C15 L12-L45; C16 L12-L39], and online connection [col. 3 lines 1-9] and availability of sufficient funds in the source account [col. 20 lines 15-25 -- see credit limit and balance never goes to zero]. Cotton does not explicitly disclose communicating the payment instruction directly to the local currency account in the second country; and wherein the payment instruction designates a beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country, separately communicating payment request; receiving a request via a web-based interface, and verifying availability of sufficient funds in the

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source account. However, verifying availability of sufficient funds in the source account is well known in the art, for examples, to withdraw money from ATM using debit card, the system checks the balance of the account before processing the payment, using credit card, the credit limit is checks before the transaction is completed, similarly, drawing a check against an checking account. Riboud discloses communicating the payment instruction directly to the local currency account in the second country; and wherein the payment instruction designates a beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country, separately communicating payment request [C1 L52 to C2 L45; C6 L35-L57; C7 L38-L53 – see “transferring, to another entity, quantities ..., via the transmission network,”] to provide a transfer system that can be used to regulate monetary flows in international transactions, this system enabling the transfer of quantities, measured in different local units of measurement, between a plurality of entities. Komem discloses communicating payment instruction directly and separately communicating payment request [abstract; Figure 1-2; C2 L18-L21; C3 L51-L61; C7 L1-L28; C9 L31-L38] to provide e-commerce transactions in multiple currency in which the local currency of the buyer (sender) is different from the local currency of the vendor (receiver) and monitor the foreign currency position in each currencies for settlement. Szoc discloses receiving a request via a web-based interface [Abstract; Figure 4A; paragraphs 0003 (cross-border payment), 0035-0041, 0052, 0074 ad claims] for receiving a client order for electronic fund transfer, from customer account, using public network (internet), and known web

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browsers to reduce transaction cost. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cotton and include communicating the payment instruction to the local currency account in the second country; and wherein the payment instruction designates a beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country, as disclosed by Riboud and Komem, to provide a settlement system that sends a payment message to another participant incurs an obligation to pay the receiving participant the amount of the transfer and monitor the foreign currency position in each currencies for settlement. Further, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Cotton, Riboud and Komem and include communication network using web-based interface, as disclosed by Szoc, to enable the user to make request for electronic fund transfer (payment) from any where that an internet is available to save time and transaction cost.

Re. Claims 2-3, Cotton discloses wherein: the payment to the local currency account is provided by exchanging the funds at the treasury account for the currency of the second country, and transferring the exchanged funds to the local currency account, and wherein: the credit entry is provided by exchanging the funds at the treasury account for the currency of the second country, and making a credit entry for the exchanged funds in a general ledger on behalf of the local currency account [C16 L22-L67].

Re. Claim 4, Cotton discloses the communicating of the payment instruction to the local currency account is independent of the communicating of the payment request to the funds source [C1 L65 to C2 L15].

Re. Claim 5, Cotton discloses wherein: the funds source draws from the source account [C5 L48-L55].

Re. Claim 6, Cotton discloses wherein: the payment instruction identifies at least one of: a currency type of the first country, the source account, and a type of financial product associated with the transaction request [C1 L64 to C2 L30; C16 L12-L23].

Re. Claim 8, Cotton discloses validating transaction data associated with the payment instruction prior to communicating the payment instruction to the local currency account [C2 29-L50].

Re. Claims 9-11, Riboud further discloses further comprising: determining an exchange rate to offer to a user that creates the transaction request for approval thereby prior to communicating the payment instruction to the local currency account, wherein the providing of the payment to, or credit entry on behalf of, the local currency account, is responsive to the exchange rate, the exchange rate is determined using data that is stored locally to the computer system, and wherein: the user is enabled to create the

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transaction request using a computer system; and the exchange rate is dynamically determined through an external foreign exchange information service [Figures 3, 5; C1 L64 to C2 L9; C7 L60-L67; C5 L53-L65; C6 L65 to C11; C8 L48 to C9 L11] to determine the conversion operation to convert local unit (local currency) to second entity (foreign currency) and transfer the amount in different currency. Further, currency exchange is well known for example, American Express office around the US and overseas daily publish foreign exchange rate of major foreign currency for travelers to provide user with information what is the conversion rate, similarly major newspapers publish the currency exchange rate for different currency. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Cotton, Komem, Szoc and Riboud to provide foreign currency conversion rate and means to transfer currency at market rate.

Re. Claim 12, Cotton discloses further comprising: querying the funds source to determine if there are sufficient funds thereat to fund the payment request [C2 L29-L41].

Re. Claim 13, Cotton discloses further comprising: debiting the source account according to the amount of the payment request [C7 L41-L46].

Re. Claim 15, Cotton discloses wherein: the currency of the local currency account is transferred to the beneficiary account via at least one intermediary financial institution in the second country [C1 L48-L54].

Re. Claims 14 and 16, Cotton, Riboud Komem does not explicitly disclose wherein: the currency of the local currency account is transferred directly to the beneficiary account without passing through an intermediary financial institution, and wherein: the local currency account comprises a Nostro account. However, Nostro accounts (Correspondent account) are well known where account is a demand deposit account or a current account, deposited by a local bank with the foreign bank in the currency of the country where the money is held. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosures Cotton, Komem and Riboud and include Nostro accounts in order to make payments in the local currency via the local payment system without intermediary.

Re. Claims 17 and 18, Cotton discloses wherein: the payment is provided to the local currency account in lieu of providing the credit entry on behalf of the local currency account according to the amount of the payment request [C8 L60 to C9 L15] and wherein: the payment is provided to the local currency account in lieu of providing the credit entry on behalf of the local currency account according to a risk profile associated with the payment request [C8 L47-L59].

Re. Claim 19, Cotton discloses wherein: the funds from the funds source are transferred to the treasury account via a clearing account [C3 L25-L76; C1 L37-L48].

Re. Claim 20, Cotton discloses wherein: the payment instruction is communicated to the local currency account in the second country via a financial interchange network [C5 L30-L46].

Re. Claim 21, Cotton further comprising: enabling tracking (convey information) of the transaction request by a user (operator) [C2 L7-L14; C21 L48-L67]. Web-based tracking is well known, for example, sending mail/parcel using UPS can be tracked using the UPS website (page). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Cotton, Riboud, Komem, and Szoc and include web-based tracking to check if the recipient has received the money or not.

Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riboud in view of Jennings et al (hereinafter Jennings – US 5,659,165).

Re. Claim 25, Riboud discloses information from a user for identifying the user and for identifying at least one account from which funds may be drawn when an international payment transaction is executed, creating a record having the information for identifying the user and for identifying the at least one account [C6 L35-L57; C7 L38-L66]. Riboud does not explicitly disclose assigning an identifier for the record to retrieving the record in order to customize the computerized user interface to enable the user to make an international payment transaction upon a subsequent access of the system by the user,

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and during an initialization access session of an international payment transaction system by a user, receiving, via a computerized user interface. However, Jennings discloses these steps [Abstract; Figures 4 (#72), 6, C1 L62 to C2 L29; C2 L6 L33-L62; C6 L32-L63; C8 L28-L52 – see identify any customer accounts associated with the card and once identification, validation have been accomplished ..., and international application] to provide interactive display screen and data input function. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Riboud and include user interface to enter his/her information (card) and PIN, as disclosed by Jennings, to access the system and initiate transferring foreign exchange.

Re. Claim 26, Jennings further discloses wherein: the customized computerized user interface enables the user to make an international payment transaction without having to re-enter the information for identifying the at least one account, and communicating with an institution at which the account is held to verify the at least one account [C1 L40-L62; C2 L30-L50; C6 L32-L63; C8 L28-L37] to initiate transaction without entering account number. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Riboud and include user interface enabling the user to initiate transaction without entering customer number, as disclosed by Jennings, to use his/her card for transaction without inputting manually account information.

Re. Claim 28, neither Riboud nor Jennings discloses further comprising: communicating with a credit-reporting bureau to obtain an indication of a credit worthiness of the user. However this step is well known, for example, if customer does not have enough deposit in his/her account or special arrangement with his/her financial institution (such as over draft) the transaction can not go through or his/her credit card does not have adequate limit to cover the transaction, the transaction is denied. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Riboud and Jennings and include communicating with a credit-reporting bureau to obtain an indication of a credit worthiness of the user to protect the financial institution from loss and fraud.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cotton in view of Riboud, Komem, Szoc and Marcous et al. (hereinafter Marcous – US 5,650,604).

Re. Claim 23, claim 23 has limitations similar to limitations of claim 1 except an added limitation: means for determining the appropriate transfer route for transaction.

As discloses above (claim 1), Cotton discloses creating a payment instruction to transfer funds from the source account to the local currency account [Abstract; Figures 2-3; col. 1 lines 37-48, lines 55-63; col. 2 lines 4-5; C4 L23 to C5 L67; col. 16 lines 15-23-- since the fund transfer is for foreign exchange, it is obvious that the accounts settlement are done in local currency, therefore the accounts are inherently in local

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currency unless it is specified the account is not in local currency, also see specification page 1 - background of invention]; communicating the payment request to a funds source associated with the source account; wherein: in accordance with the payment request, funds are transferred from the funds source (source account) to a treasury (FRB2) account if necessary to maintain a balance at the treasury account which is sufficient to cover an amount of the payment request, and funds at the treasury account are used to provide at least one of (a) a payment to and receiving from a user via a network a transaction request to transfer funds from the source account to the local currency [Cotton – C1 L10-L64; C2 L50 to C3 L15; C3 L65-67; C15 L12-L45; C16 L12-L39], and online connection [col. 3 lines 1-9] and availability of sufficient funds in the source account [col. 20 lines 15-25 -- see credit limit and balance never goes to zero]. Cotton does not explicitly disclose communicating the payment instruction directly to the local currency account in the second country; and wherein the payment instruction designates a beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country, separately communicating payment request; receiving a request via a web-based interface, and verifying availability of sufficient funds in the source account, and

means for determining the appropriate transfer route for transaction.

However, verifying availability of sufficient funds in the source account is well known in the art, for examples, to withdraw money from ATM using debit card, the system checks the balance of the account before processing the payment, using credit

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card, the credit limit is checks before the transaction is completed, similarly, drawing a check against an checking account, similarly the check (checking account) routing numbers are well known in the art. Riboud discloses communicating the payment instruction directly to the local currency account in the second country; and wherein the payment instruction designates a beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country, separately communicating payment request [C1 L52 to C2 L45; C6 L35-L57; C7 L38-L53 – see “transferring, to another entity, quantities ..., via the transmission network,”] to provide a transfer system that can be used to regulate monetary flows in international transactions, this system enabling the transfer of quantities, measured in different local units of measurement, between a plurality of entities. Komem discloses communicating payment instruction directly and separately communicating payment request [abstract; Figure 1-2; C2 L18-L21; C3 L51-L61; C7 L1-L28; C9 L31-L38] to provide e-commerce transactions in multiple currency in which the local currency of the buyer (sender) is different from the local currency of the vendor (receiver) and monitor the foreign currency position in each currencies for settlement. Szoc discloses receiving a request via a web-based interface [Abstract; Figure 4A; paragraphs 0003 (cross-border payment), 0035-0041, 0052, 0074 ad claims] for receiving a client order for electronic fund transfer, from customer account, using public network (internet), and known web browsers to reduce transaction cost.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cotton and include communicating the payment instruction to the local currency account in the second country; and wherein the payment instruction designates a beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country and communication network and payment using web-based interface, as disclosed by Riboud, Komem and Szoc, to provide a settlement system that sends a payment message to another participant incurs an obligation to pay the receiving participant the amount of the transfer and monitor the foreign currency position in each currencies for settlement and include communication network using web interface to enable the user to make request for electronic fund transfer (payment) from any where that an internet is available to save time and transaction cost.

Cotton, Riboud, Komem or Szoc does not explicitly disclose means for determining the appropriate transfer route for transaction. However, Marcous discloses means for determining the appropriate transfer route for transaction [col. 5 lines 38-50] to communicate the transaction to appropriate destination terminal where the destination terminal receive the specified funds authorization to be provided to the recipient. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cotton, Riboud, Komem and Szoc and include means for determining the appropriate transfer route for transaction,

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as disclosed by Marcous, to forward the request for fund to appropriate terminal (destination) without getting lost which saves process time.

Response to Arguments

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

Downing et al. (US 5,963,647) discloses a system and method for transferring funds to an individual. More particularly, the present invention relates to a system and method for transferring funds by assigning a password to funds to be transferred to a recipient so that the recipient can subsequently access the funds.

Amos (US 6554184) discloses devices used to transfer funds or currency by electronic means. It is well know in the art that the money transfer industry requires using an Agent, usually a franchised store's clerk with cash or credit, telephonic means or EDI means with credit to transfer funds from one individual at a proximal location to another individual or entity at a distal location. MoneyGram, Western Union, CyberCash and others operate in this fashion. In a broad sense the invention is a

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combination of apparatuses which in itself is an apparatus used to transfer money or funds and the invention is a system used to transfer money.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
Art Unit 3628

Harish T Dass

6/2/06